

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2625**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Bert PEETERS

Group Art Unit: 2625

Application No.: 10/046,216

Examiner: J. ROHWER

Filed: January 16, 2002

Docket No.: 111353

For: BILLING PROCESS FOR PRINTING SYSTEMS

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the January 25, 2007 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-20 are pending in this application.

Applicant appreciates the courtesies shown to Applicant's representatives by Examiner Rohwer and Examiner Grant in the March 28, 2007 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

In particular, Examiner Rohwer agreed to consider the following arguments and contact the Applicant's representatives should he have any questions, comments or concerns regarding this application. Furthermore, the Examiner was invited to contact the Applicant's representatives should he and/or his supervisors believe anything further is needed to place the application in condition for allowance.

The interview summary states that the "[d]iscussion centered around the limitation 'network' as defined in the claims, used broadly in the sense that one interpretation of a network could be a series of components within one housing, and how the White reference interfaces or connects the Billing Manager to the Printing Device as disclosed in the reference. Examiners and the Applicant agreed there are differences between the instant application and White, more specifically that the instant application is [a] stand alone device integrating specific limitations into one device, while White uses a network connection to integrate the same claim limitations."

Applicant disagrees with the statement made in the Interview Summary except in that the present application is distinguishable from U.S. Patent Application Publication No. 2003/0074312 (White). Namely, Applicant submits that all of the recited features of the presently claimed invention are novel in view of the applied references.

I. Claim Rejections under 35 U.S.C. § 103

The Office Action rejects claims 1-4, 6, 8-11, 13-15 and 18-19 under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2003/0074312 (White) in view of U.S. Patent No. 7,072,850 (Van Luchene) and further in view of U.S. Patent No. 5,802,496 (Uchiyama). Further, the Office Action rejects claims 5 and 16 under 35 U.S.C. § 103(a) over White, Van Luchene and Uchiyama, further in view of U.S. Patent Application Publication No. 2002/0069168 (Lee); rejects claims 7 and 17 under 35 U.S.C. § 103(a) over White, Van Luchene and Uchiyama, further in view of "commonly known art at the time of the invention;" and rejects claims 12 and 20 under 35 U.S.C. § 103(a) over White, Van Luchene, and Uchiyama, in view of U.S. Patent Application Publication No. 2003/0149661 (Mitchell). These rejections are respectfully traversed.

More specifically, the Office Action asserts that it would have been obvious to combine the applied references White, Van Luchene and Uchiyama to obtain the features of

claims 1 and 13. Claim 1 recites: a method of performing a billing process for the copies or prints, wherein the method comprises: (a) in the printing system, accessing the memory to retrieve product usage data without communicating over a network; (b) in the printing system, calculating billing data using the retrieved product usage data without communicating over a network; (c) in the printing system, presenting a bill to the customer; (d) in the printing system, receiving authorization information indicating whether the customer authorizes the billing data; and (e) if said authorization information indicates that the customer has authorized the billing data, sending a message from the printing system to the billing service over a network.

Claim 13 recites: a printing system comprising: (a) a memory storing product usage data indicating a measurement of the actual use of the printing system by a customer without communicating over a network; (b) a billing control unit for accessing the memory to retrieve said product usage data without communicating over a network; (c) a user interface message delivery subsystem for presenting a bill to the customer based on said billing data and for receiving user input from the customer indicating whether the customer authorizes the billing data; and (d) a message sending unit for sending a message from the printing system to a billing service over a network if said user input indicates that the customer has authorized the billing data.

The Office Action acknowledges that White does not expressly disclose that in the printing system, the billing manager retrieves the product usage data and calculates billing data using the product usage data, without communicating over a network. However, the Office Action combines Van Luchene and Uchiyama with White to disclose the features of the presently claimed invention. Applicant respectfully disagrees that such a combination is proper. More specifically, it is not obvious to combine Van Luchene with White at least because Van Luchene is non-analogous to White.

Van Luchene relates to a method of utilizing POS terminals to facilitate the sales of aging inventory through the use of upsells. Upsells are essentially the rounding up to the nearest whole dollar or multiple thereof, and allowing customers to replace the upsells created with the supplier's inventory. The idea is, rather than requesting change from their purchase, the amount that would otherwise would be change would be re-directed to the purchase of inventory. In contrast, White and the presently claimed invention deal with a printing and copying system that communicates over a network. White and the presently claimed invention do not involve any inventory or the use of upsells in each transaction - instead, each data usage measurement has a fixed cost.

MPEP § 2141.01(a) provides that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." Further, it provides "[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."

Van Luchene is not in the same field of Applicant's endeavor because Van Luchene is directed to a system for the facilitation of the sales of inventory rather than a method of billing for usage of printing and/or copying series. Furthermore, Van Luchene is not directed to solving the same problem as the presently claimed invention because the presently claimed invention does not use the concept of upsells and instead is directed at a billing system for minimizing the amount of communication between printer/copier and billing manager. Thus, Van Luchene is not analogous art to the presently claimed invention and at least for these reasons the rejection is improper.

Furthermore, MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of at least independent claims 1 and 13 under the combination of White and Van Luchene is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine the references.

In the alternative, the Office Action rejects claims 1 and 13 as obvious over the combination of White and Uchiyama. Uchiyama relates to "a business transaction data accumulating system having a plurality of POS terminals and an accumulating device. Each POS terminal includes a failure detecting device for detecting a communication line failure and a recording device for recording business transaction data if a communication line failure is detected." The Office Action suggests the motivation for such a combination of White and Uchiyama "would have been to provide a transaction system and business accumulation data that can continue to function without the use of a communication line. Additionally, further motivation is provided in the sense that POS terminals that store the local billing attributes and an inventory database, are able to continue to conduct business relying only on its own computer, and not dependent on a master computer or server."

In contrast, White teaches the use of a printing and billing system wherein the system requires customer authorization to be given prior to the document being sent to the printer. The customer authorization is provided over the network between the billing manager and the customer. Thus, White specifically relies on the presence of the network to continue to operate.

If there were a communication line failure, then no authorization could be given to the printing system and the system could not continue to operate. Therefore, Uchiyama is essentially teaching away from White, because the entire system in Uchiyama can continue to operate despite a communication line failure, however, White expressly relies on such a communication line to continue to operate. Thus, the Applicant respectfully submits that such a combination of White, Van Luchene and Uchiyama is inappropriate.

More specifically, MPEP § 2143.01.VI states "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." Applicant respectfully submits that the rejection of at least independent claims 1 and 13 under the combination of White, Van Luchene and Uchiyama is improper in view of at least MPEP §2143.01.VI because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine the references.

Accordingly, reconsideration and withdrawal of the rejection of independent claims 1 and 13 under 35 U.S.C. §103(a) as being unpatentable over any combination of the applied prior art references are respectfully requested. Because claims 2-12 and 14-20 depend from claims 1 and 13, respectively, reconsideration and withdrawal of the rejection of claims 2-12 and 14-20 is also respectfully requested.

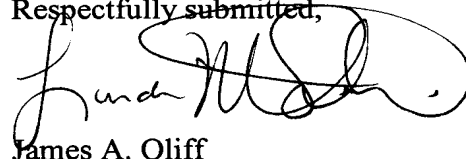
Lee, Mitchell and "commonly known art at the time of the invention" fail to cure the deficiencies of White, Van Luchene and Uchiyama. Thus, the applied references, in any combination, fail to teach or suggest the subject matter of claims 5, 7, 12, 16-17 and 20. Withdrawal of the rejections is requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration, and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:LMS/dqs

Date: March 30, 2007

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